Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number Q61623	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 09/716,273	Filed November 21, 2000
	First Named Inventor Hubert HELAINE	
	Art Unit 2617	Examiner Khawar IQBAL

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23373
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

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December 23, 2008
Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Docket No: Q61623

Hubert HELAINE, et al.

Appln. No.: 09/716,273 Group Art Unit: 2617

Confirmation No.: 8432 Examiner: Khawar IQBAL

Filed: November 21, 2000

For: HOME AND ROAMING PROVISIONING METHOD FOR MOBILE TERMINALS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated June 23, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Appellant turns now to the rejections at issue: claims 1-2, 4-9, 11-16, 18-21, 25-28, 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Cassidy, et al. (US Patent No. 6,480,725) in view of Karlsson, et al. (US Patent No. 6,226,523) and Shah (US Patent No. 6,029,065). Appellant respectfully requests reversal of this rejection at least in view of the following comments.

The Examiner asserts that Cassidy discloses a "telecommunication terminal for accessing a data network via an access network **using a set of provisioning data**," as set forth in claim 1, citing Figs. 1, and 5-7 in support. However, contrary to the Examiner's assertion, Cassidy is directed to a telephone for storing information on a user. Specifically, a data card, such as a smart card, stores subscriber related information and is inserted in a telephone to transfer

information to the telephone (col. 1, lines 30-35). Therefore, Cassidy discloses a telephone capable of storing its own identification information as well as storing a card for storing subscriber identification information (col. 2, lines 20-27). However, Cassidy does not disclose accessing a data network via an access network using a set of provisioning data. Cassidy merely discloses a telephone capable of storing its own information as well as subscriber identification information. Karlsson only discloses that information regarding the access privileges of a mobile station and a remote host are stored in a database located in a Home Location Register (HLR) and Shah only discloses a mobile phone is pre-programmed with a service option for changing or adding extended subscriber features.

Claim 1 further recites "means for storing **a current set of primary provisioning data that is updated automatically without intervention of the terminal user**." The Examiner asserts that the subscriber data stored on the SIM card 10 of Cassidy teaches this aspect of the claim citing (col. 4, lines 25-57 and col. 5, lines 15-28). Cassidy cited by the Examiner disclose a handset with a memory module receiver which can receive a memory module such as a subscriber identify module (SIM) card. The SIM card stores subscriber related data and subscriber related information. Further, Cassidy discloses the operation of a telephone with a SIM card. When a SIM card is present in the telephone and there is no change in the presence of the SIM card, the phone operates the same as that of a conventional SIM card.

However, there is no teaching or suggestion that the information which is on a SIM card (which the Examiner asserts teaches means for storing a current set of primary provisioning data) is updated automatically without intervention of the terminal user. Specifically, there is no suggestion regarding the updating of information on a SIM card, let alone, that information on a

SIM card is updated automatically without intervention of the terminal user. Karlsson only discloses storing data in a database (HLR) and does not suggest that information in the user terminal is automatically updated without intervention of the terminal user. Shah only discloses extended subscriber features and not provisioning data.

Claim 1 further recites "means for storing **at least one set of protected primary provisioning data that cannot be updated without the intervention of the terminal user**." The Examiner asserts that Cassidy discloses means for storing at least one set of protected primary provisioning data and concedes that Cassidy and Karlsson do not teach means for storing at least one set of protected primary provisioning data that cannot be updated without the intervention of the terminal user" and cites Shah, col. 8, lines 32-47, to cure the deficiency.

Shah discloses a mobile phone is pre-programmed with a service option for changing or adding extended subscriber features. A mobile phone will also have extended features changes codes (EFCC's) in its memory. If a user refuses additional billing, no downloading will occur. A number of different EFCC's may be used for different feature codes so that the user may elect the feature codes individually to avoid being billed for access to all possible optional extended features when only one is desired. However, extended features are not protected provisioning data and are updated based on user elections. In addition, the combination of Cassidy with Shah is not obvious. Specifically, there is no suggestion that the SIM card of Cassidy (col. 5, lines 20-54, alleged means for storing at least one set of protected primary provisioning data), would be modified to store at least one set of protected primary provisioning data that cannot be updated without the intervention of the terminal user. Specifically, there is no suggestion in Cassidy that the SIM card should store EFCC's or that the SIM card should be modified so as to store EFCC's

(alleged primary provisioning data that cannot be updated without the intervention of the terminal user) or that the EFCC's stored on a SIM card cannot be updated without the intervention of the terminal user. Cassidy merely discloses that the SIM card can be detected and the telephone operates accordingly. Further, a user can enter PIN information if required. If a SIM card has not been inserted in a phone, then the phone operates in a conventional manner. There is no reason to modify the SIM card of Cassidy so that it cannot be updated without the intervention of the terminal user absent impermissible hindsight upon viewing the Applicant's disclosure.

Claim 1 also recites "wherein **the protected primary provisioning data** is information establishing a connection to the data network in a home access network.." The Examiner concedes that Cassidy does not teach this aspect of the claim and cites Karlsson, col. 3, lines 15-47. Karlsson discloses that information regarding the access privileges of a mobile station and a remote host are stored in a database located in a Home Location Register (HLR) and not in the SIM card of the terminal. The Examiner argued that the subscriber information stored on a SIM card teaches the claimed protected primary provisioning data. However, there is no teaching or suggestion that the subscriber information on a SIM card is information establishing a connection to the data network in a home access network.

For at least the above reasons, claim 1 and its dependent clams should be deemed allowable. To the extent independent claims 8, 15, 23 and 27 recite similar subject matter, claims 8, 15, 23, and 27 and their dependent claims should be deemed allowable for at least the same reasons.

Claim 8 recites "the current set of provisioning data comprises roaming information establishing a connection to the data network in a visiting access network" and claim 32 recites: "wherein, when the selecting means selects the current set of primary provisioning data, the terminal is roaming in a visiting access network and the selected current set of the primary provisioning data is roaming information that establishes a connection to that data network via the visiting access network." The Examiner relies on Karlsson (col. 3, lines 15-47) but there is no suggestion that provisioning data comprises **roaming information** establishing a connection to the data network in a visiting access network, as detailed in the Amendment under 37 C.F.R. § 1.116 incorporated by reference.

Claims 23-24, and 30-31 under 35 USC § 103(a) as being unpatentable over Cassidy in view of Shah (US Patent No. 6,029,065). To the extent claim 23 recites subject matter similar to claim 1, claim 23 and its dependent claims should be deemed allowable for at least the same reasons. Claims 3, 10, and 17 under 35 USC § 103(a) as being unpatentable over Cassidy in view of Karlsson and Shah and further in view of Beaudou (US Patent No. 6,671,522). Claims 3, 10 and 17 should be deemed allowable by virtue of their dependency to claims 1, 8 and 15 for at least the reasons set forth above. Moreover, Beaudou does not cure the deficiencies of Cassidy, Karlsson and Shah. Appellant respectfully requests the reversal of the rejections.

Respectfully submitted,

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